

Appl. No. 09/773,241
Atty. Docket No. 8409
Amdt. dated June 24, 2005
Reply to Office Action of March 24, 2005
Customer No. 27752

REMARKS

Claim Status

Claims 1 and 5-19 are pending in the present application. No additional claims fee is believed to be due.

Claims 2, 3, and 4, are canceled without prejudice.

Claim 1 has been amended to more specifically characterize the claimed invention. Support for the amendment can be found, for example, in the specification in claims 2, 3, and 4, as originally filed, in Figures 1-9, and on page 11, lines 21-22.

Claims 5, 6, 9, 11, and 16-19 have been amended such that they depend from claim 1 instead of canceled claim 2. Support for these amendments can be found in the claims as originally filed. Further, claims 8, 13, and 16-19 have been amended to correct antecedent basis issues with amended claim 1. Support for these amendments can be found, for example, in the specification on page 11, lines 21-22.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Claim Objections

The Office Action has objected to claim 1 because of the phrase "at least one discontinuity is neither directly nor indirectly connected to the outer periphery". The Office Action requests appropriate correction and / or clarification. Applicants have amended claim 1 to provide both clarification and appropriate correction.

Rejection Under 35 USC §102 Over Aledo et al.

The Office Action has rejected claims 1-3, 5-10, 14, and 16-17, under 35 U.S.C. § 102(b) as anticipated by U.S. Pat. No. 4,850,988 issued to Aledo et al., hereafter "Aledo". Applicants respectfully traverse the rejection by the Office Action because the cited reference fails to teach every element of amended claim 1.

First, the discontinuity of Aledo is not "limited to the inner region" or "bounded by the side panel", as is recited, in part, in amended claim 1. It is well settled that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v.*

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Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Case law further provides that “[i]n the absence of an express intent to impart a novel meaning to the claim terms, the words take on the full breadth of the ordinary and customary meanings attributed to them by those of ordinary skill in the art.” *Ferguson Beauregard/Logic Controls v. Mega Systems*, 350 F.3d 1327, 1338, 69 USPQ 1001, 1009 (Fed. Cir. 2003). A claim term’s ordinary and customary meaning may be determined by reviewing “the written description, the drawings, and the prosecution history.” *Id.* (citing *DeMarini Sports, Inc. v. Worth, Inc.* 239 F.3d 1314 (Fed. Cir. 2001). “It is the use of the words in the context of the written description and customarily by those skilled in the relevant art that accurately reflects both the ordinary and customary meaning of the terms in the claims of a patent.” *Ferguson* 350 F.3d at 1338.

Amended claim 1 recites, *inter alia*, that the at least one elastomeric side panel includes “an outer periphery and an inner region having at least one discontinuity limited to the inner region... wherein the at least one discontinuity is bounded by the side panel.” The term “inner region” is defined in the specification as shown in Figures 1-9. The inner region is shown to be an area of the side panel bounded by an outer periphery.

The term “bounded” means “to identify the boundaries of”. (THE AMERICAN HERITAGE COLLEGE DICTIONARY 169 (4th ed. 2002). Thus, as recited, in part, in amended claim 1, the side panel identifies all of the boundaries of the at least one discontinuity. Moreover, for the purposes of the present invention and as shown in the application, regardless of whether a single discontinuity or a plurality of discontinuities exist, e.g. 260, 254, 256, 264, 266, 268, and 270, all are shown to be bounded by the side panel in which they reside.

In contrast, Aledo teaches a slit 17 and a slit 19 each of which extend from their side edges or side margins, respectively, inward and terminate at a circular cutout 18. (col. 3, lines 48-51; col. 4, lines 26-32). Neither of the slits 17 or 19 are bounded by the side panel of Aledo. Further, Aledo teaches that the circular cutout 18 is connected to the slits 17 and 19. (See Figures 1-3). Because the slits 17 and 19 are a part of the circular cutout 18, the circular cutout 18 is not bounded by the side panel. Therefore, Aledo does not teach an elastomeric “side panel... having at least one discontinuity... wherein the at least one discontinuity is bounded by the at least one elastomeric side panel”, as is recited, in part in amended claim 1.

Second, as stated in the Office Action, Aledo also fails to disclose “wherein the waist region has an extensibility varying from about 5 g/mm to about 50 g/mm and the

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leg region has an extensibility varying from about 1 g/mm to about 30 g/mm" as is recited, in part, in amended claim 1. (Office Action page 9). Because Aledo fails to teach all of the claim elements of amended claim 1, Aledo does not anticipate claim 1.

Regarding claims 16 and 17, the Office Action cites Figures 1, 2, and 3, members 15 and 16, in its rejection. It is well settled that drawings and pictures can be used as prior art. MPEP §2125. However, in order for a drawing or picture to anticipate a claim, the drawing or picture must clearly show the claimed structure. *In re Mraz*, 455 F.2d 1069, 173 USPQ 25 (CCPA 1972). Moreover, all of the claimed structural features and how they are put together, must be shown by the picture as well. *Jockmus v. Leviton*, 28 F.2d 812 (2d Cir. 1928). Where "the reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing features are of little value." MPEP §2125 citing *Hockerson-Halberstadt, Inc. v. Avia Group Int'l*, 222 F.3d 951, 956, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000). The drawings and the description combined can be relied on "for what they would reasonably teach one of ordinary skill in the art." *Id.* citing *In re Wright*, 569 F.2d 1124, 193 USPQ 332 (CCPA 1977).

Amended claim 16 recites, in part, that a waist-directing force in the waist region of the elastomeric side panel extends at an angle ranging from about 0° to about 45° relative to a lateral centerline of the disposable article." Amended claim 16 further recites that "a leg-directing force in the leg region of the elastomeric side panel extends at an angle ranging from about 10° to about 35° relative to the lateral centerline of the disposable absorbent article." Amended claim 17 recites, in part, that the waist-directing force and the leg-directing force can be in ranges from about 10° to about 15° and 20° to about 30°, respectively.

In contrast, Aledo makes no mention of waist-directing forces in the waist region and at which angle the waist-directing forces extend. Similarly, Aledo makes no mention of leg-directing forces in the leg region and at which angle the leg-directing forces extend. Consequently, the Office Action's reliance on the Figures of Aledo cannot provide the basis for an anticipation rejection where Aledo is silent with regard to the figures being to scale.

For the foregoing reasons, Aledo fails to teach all of the claim elements of amended claim 1. Because claims 5-10 and 14 depend from claim 1, Aledo similarly fails to teach all of their claim elements. Additionally, Aledo fails to teach the claim elements of amended claims 16 and 17 for the reasons discussed above and because claims 16 and

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17 depend from claim 1. Consequently, Applicants assert that claims 1, 5-10, 14, and 16-17, are in condition for allowance.

Rejection Under 35 USC §102 Over Heki et al.

The Office Action has rejected claims 1-2, 6-7, and 9-12, under 35 U.S.C. § 102(b) as anticipated by U.S. Pat. No. 5,906,008 issued to Heki et al., hereafter "Heki". Applicants respectfully traverse the rejection by the Office Action because the cited reference fails to teach every element of amended claim 1.

Heki discloses a disposable diaper having an absorbent pair of ears which extend outward from opposite side edges of the disposable diaper. (Abstract). Heki further teaches that the disposable diaper may include ear parts 6 which can have a stress relaxing structure 20. (col. 10, lines 3-17). Heki further teaches that the "stress relaxing structure 20 may be a single slit 21a provided that the single slit 21a is capable of intercepting the transmission of a tensile force applied to the ear part 6." (col. 10, lines 17-20).

However, Heki does not teach that a waist region of an elastomeric side panel can have "an extensibility varying from about 5 g/mm to about 50 g/mm" and a leg region of an elastomeric side panel can have "an extensibility varying from about 1 g/mm to about 30 g/mm", as is recited, in part, in amended claim 1. Thus, Heki does not teach all of the claim elements of amended claim 1. So, claim 1 is not anticipated by Heki. Moreover, because claims 6-7 and 9-12 depend from amended claim 1, they too are not anticipated by Heki. Consequently, Applicants assert that claims 1, 6-7, and 9-12, are in condition for allowance.

Rejection Under 35 USC §103(a) Over Aledo

The Office Action has rejected claims 4, 18, and 19, under 35 U.S.C. § 103(a) as being obvious in view of Aledo. Applicants respectfully traverse the rejection of the Office Action because the Office Action fails to establish a *prima facie* case of obviousness.

It is well settled that in order to establish a *prima facie* case of obviousness, three requirements must be met. MPEP §2143. First, there must be some suggestion or motivation, either in the cited references or in the knowledge generally available to one ordinarily skilled in the art, to modify the reference. *Id.* Second, there must be some

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reasonable expectation of success. *Id.* Third, the cited references must teach or suggest all of the claim limitations. *Id.*

First, Aledo fails to teach all of the claim elements of amended claim 1. The claim elements of claim 4 have been added to amended claim 1 such that amended claim 1 recites, in part, that a waist region of an elastomeric side panel can have “an extensibility varying from about 5 g/mm to about 50 g/mm” and a leg region of an elastomeric side panel can have “an extensibility varying from about 1 g/mm to about 30 g/mm”. Claim 1 further recites, that the at least one elastomeric side panel is “carried by the containment assembly” and extends “outwardly from the first longitudinal edge of the containment assembly adjacent to the first end edge of the containment assembly.”

The Office Action states that because Aledo teaches elastic extensibility in the waist and leg areas, citing Figure 1, members 13 and 14, “it would have been obvious to... modify the waist and leg elasticity with specific parameters.” (Office Action page 10). The Office Action further states that “where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.” (*Id.*).

However, Aledo does not disclose the general conditions of amended claim 1. Aledo makes no mention of whether a side panel can be elastomeric. Aledo does teach that elastic elements 13 and 14 can be disposed in a diaper 10. (See Figure 3). However, neither of the elastic elements 13 or 14 are shown to extend to the side panel. Furthermore, Aledo does not teach whether the side panels can be elastomeric. Thus, Aledo does not teach or suggest all of the claim elements of amended claim 1.

Second, for the reasons stated previously in regard to the at least one discontinuity being bounded by the side panel, Aledo fails to teach or suggest all of the claim elements of the amended claim 1.

Because Aledo fails to teach or suggest all of the claim elements of amended claim 1, the Office Action has failed to establish a *prima facie* case of obviousness against amended claim 1. Furthermore, because claims 18 and 19 depend from amended claim 1, Aledo similarly fails to teach or suggest all of their claim elements. So, the Office Action has failed to establish a *prima facie* case of obviousness against claims 18 and 19. Consequently, Applicants assert that claims 1, 18, and 19, are in condition for allowance.

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Rejection Under 35 USC §103(a) Over Aledo

The Office Action has rejected claims 13-15 under 35 U.S.C. § 103(a) as being obvious in view of Heki. Applicants respectfully traverse the rejection of the Office Action because the Office Action fails to establish a *prima facie* case of obviousness.

For the reasons asserted above, in regard to the anticipation rejection over Heki, Applicants assert that Heki does not teach or suggest all of the claim elements of amended claim 1. Because claims 13-15 depend from amended claim 1, Heki similarly fails to teach or suggest all of their claim elements as well. Consequently, the Office Action has not established a *prima facie* case of obviousness against claims 13-15. Applicants therefore assert that claims 13-15 are in condition for allowance.

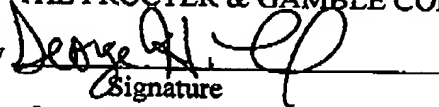
Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejections under §102(b) and 1103(a). In view of the foregoing, reconsideration of this application, entry of the amendments presented herein, and allowance of Claims 1 and 5-19 is respectfully requested.

Respectfully submitted,

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